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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/845,396	04/30/2001	Wayne L. Randell	32423/82536	2724

7590 03/28/2008  
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EXAMINER
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LIVERSEDGE, JENNIFER L

ART UNIT	PAPER NUMBER
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3692

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03/28/2008

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 09/845,396	<b>Applicant(s)</b> RANDELL ET AL.	
	<b>Examiner</b> Jennifer Liversedge	<b>Art Unit</b> 3692	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 17 January 2008.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 48 and 50-116 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 48 and 50-116 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Response to Amendment***

This Office Action is responsive to Applicant's amendment and request for reconsideration of application 09/845,396 filed on January 17, 2008.

The claims remain as submitted on January 18, 2007.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 48 and 50-116 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent No. 6,826,542 B1 to Virgin et al. (further referred to as Virgin), and further in view of US Pub No 2003/0167229 A1 to Ludwig et al. (further referred to as Ludwig).

Regarding claims 48, 50-71 and 116, Virgin discloses a process for online invoice presentment and processing (columns 1-14; particularly column 3, lines 52-58), comprising:

a) generating at a biller entity an invoice for a service rendered to a customer entity (column 3, lines 54-56; Figure 4);

b) making information on the invoice electronically available to first and second users associated to the customer entity, the first user being associated with a first customer computing unit and the second user being associated with a second customer computing unit (column 2, lines 43-49; column 10, lines 25-56);

including enabling users to approve and authorize the invoice based on respective invoice handling privileges assigned by the customer to the user (column 10, lines 32-56; column 11, lines 6-23; column 13, lines 21-36);

where an identifier is processed to determine if users have invoice approval and authorization privileges (column 11, lines 6-23);

transmitting over the communications network from the second customer computing unit to the biller entity payment remittance information including data selected from the set consisting of a credit card number, an authorization to debit a bank account, wire transfer information, direct deposit information and an indication that a check will be mailed (Figure 11; column 14, lines 48-54).

Virgin does not disclose transmitting over a communications network from the first customer computing unit to the biller entity a first data element indicating that the first user has approved the invoice and transmitting over the communications network from the second customer computing unit to the biller entity a second data element indicating that the second user has authorized payment of the invoice.

However, Virgin does disclose enabling invoicers to view the payment status, such as partially approved and approved within the multi-level rule-based routing process (column 2, lines 43-54).

Further, Ludwig discloses transmitting over a communications network from the first customer computing unit to the biller entity a first data element indicating that the first user has approved the invoice and transmitting over the communications network from the second customer computing unit to the biller entity a second data element indicating that the second user has authorized payment of the invoice (pages 1-22, specifically such as page 14, paragraph 96; page 19, paragraph 124; page 21, paragraphs 137 and 139; page 22, paragraph 143).

It would be obvious to one of ordinary skill in the art at the time of the invention to modify the authorization process for an online invoice as disclosed by Virgin to adapt the use of notifying a biller of invoice authorization progress as disclosed by Ludwig. The motivation would be to provide a means of tracking the progress of obtaining invoice approvals where the invoicer is not required to take the active step of reviewing the status (Virgin requires active viewing of approval/authorization steps whereas Ludwig provides automatic notification of each successive approval/authorization step).

Regarding claims 72-96, Virgin discloses a process (columns 1-14), comprising:

- a) rendering a service to a customer entity (column 1, lines 21-28);
- b) generating an invoice for the service (column 3, lines 54-56; Figure 4);
- c) making available to first and second users associated to the customer entity an electronic document providing information on the invoice (column 2, lines 43-49; column 10, lines 25-56);

d) providing in the electronic document a user interface control, the user interface control providing a first input option to approve the invoice and a second input option to authorize payment of the invoice, the second input being distinct from the first input option (column 2, lines 43-61; column 10, lines 27-56; column 11, lines 6-23; column 13, lines 21-36);

including enabling users to approve and authorize the invoice based on respective invoice handling privileges assigned by the customer to the user (column 10, lines 32-56; column 11, lines 6-23; column 13, lines 21-36);

invoice information includes an invoice identifier and amount of money billed under the invoice and where a complete copy of the invoice can be accessed (Figure 11; column 14, lines 48-54)

where an identifier is processed to determine if users have invoice approval and authorization privileges (column 11, lines 6-23);

transmitting over the communications network from the second customer computing unit to the biller entity payment remittance information including data selected from the set consisting of a credit card number, an authorization to debit a bank account, wire transfer information, direct deposit information and an indication that a check will be mailed (Figure 11; column 14, lines 48-54);

wherein the invoice is associated with a given category selected from a plurality of categories, the invoice handling privileges assigned by the customer entity to the first user being associated with respective categories and including invoice approval

privileges with the given category (column 2, lines 5-16 and lines 43-49; column 10, lines 27-56; column 11, lines 6-23; column 13, lines 10-36).

Virgin does not specifically disclose detecting granting of payment of the invoice only when the first user has approved the invoice via the first input option and the second user has authorized payment of the invoice via the second input option.

Virgin discloses enabling invoicers to view the payment status, such as partially approved and approved within the multi-level rule-based routing process (column 2, lines 43-54).

Further, Ludwig discloses detecting granting of payment of the invoice only when the first user has approved the invoice via the first input option and the second user has authorized payment of the invoice via the second input option (pages 1-22, specifically such as page 14, paragraph 96; page 19, paragraph 124; page 21, paragraphs 137 and 139; page 22, paragraph 143).

It would be obvious to one of ordinary skill in the art at the time of the invention to modify the authorization process for an online invoice as disclosed by Virgin to adapt the use of detecting granting of payment by an invoicer as disclosed by Ludwig. The motivation would be to provide a means of tracking the progress of obtaining invoice approvals and a paid invoice where the invoicer is not required to take the active step of reviewing the status (Virgin requires active viewing of approval/authorization steps whereas Ludwig provides automatic notification of each successive approval/authorization step through to payment complete).

Regarding claims 97-112, Virgin discloses a process for granting payment of an invoice over a network, the invoice having been issued by a biller entity to a customer entity (columns 1-14; particularly column 3, lines 52-58), said process comprising:

a) accessing via a computer information on the invoice (column 3, lines 52-58);  
where an identifier is processed to determine if users have invoice approval and authorization privileges (column 11, lines 6-23);

transmitting over the communications network from the second customer computing unit to the biller entity payment remittance information including data selected from the set consisting of a credit card number, an authorization to debit a bank account, wire transfer information, direct deposit information and an indication that a check will be mailed (Figure 11; column 14, lines 48-54);

wherein the invoice is associated with a given category selected from a plurality of categories, the invoice handling privileges assigned by the customer entity to the first user being associated with respective categories and including invoice approval privileges with the given category (column 2, lines 5-16 and lines 43-49; column 10, lines 27-56; column 11, lines 6-23; column 13, lines 10-36).

b) transmitting from the customer entity to the biller entity a first data element indicating that the invoice has been approved by a first user associated with the customer entity (column 2, lines 43-61; column 14, lines 20-59);



c) transmitting from the customer entity to the biller entity a second data element indicating that payment of the invoice has been authorized by a second user associated with the customer entity (column 2, lines 43-61; column 14, lines 20-59);

Virgin does not disclose transmitting from the customer entity a first data element indicating that the invoice has been approved by a first user associated with the customer entity and transmitting from the customer entity to the biller entity a second data element indicating that payment of the invoice has been authorized by a second user associated with the customer entity.

However, Virgin does disclose enabling invoicers to view the payment status, such as partially approved and approved within the multi-level rule-based routing process (column 2, lines 43-54).

Further, Ludwig discloses transmitting from the customer entity a first data element indicating that the invoice has been approved by a first user associated with the customer entity and transmitting from the customer entity to the biller entity a second data element indicating that payment of the invoice has been authorized by a second user associated with the customer entity (pages 1-22, specifically such as page 14, paragraph 96; page 19, paragraph 124; page 21, paragraphs 137 and 139; page 22, paragraph 143).

It would be obvious to one of ordinary skill in the art at the time of the invention to modify the authorization process for an online invoice as disclosed by Virgin to adapt the use of notifying a biller of invoice authorization progress as disclosed by Ludwig. The motivation would be to provide a means of tracking the progress of obtaining invoice

approvals where the invoicer is not required to take the active step of reviewing the status (Virgin requires active viewing of approval/authorization steps whereas Ludwig provides automatic notification of each successive approval/authorization step).

Regarding claims 113-115, Virgin discloses a method for electronically presenting and granting payment of invoices (columns 1-14; particularly column 3, lines 52-58), comprising:

- a) generating at a biller entity an invoice for a service rendered to a customer entity (column 3, lines 54-56; Figure 4);

- b) making information on the invoice electronically available to the customer entity (column 3, lines 54-62);

- c) enabling at least two users associated to the customer entity to complete respective stages of a multi-stage invoice handling process (column 2, lines 5-16 and lines 43-54; column 10, lines 25-56; column 11, lines 6-23);

wherein the multi-stage handling process includes a first and second stage.

Virgin does not disclose transmitting over a communications network from each of said at least two users to the biller entity a respective data element indicating that the respective stage of the multi-stage invoice handling process has been completed.

However, Virgin does disclose enabling invoicers to view the payment status, such as partially approved and approved within the multi-level rule-based routing process (column 2, lines 43-54).

Further, Ludwig discloses transmitting over a communications network from each of said at least two users to the biller entity a respective data element indicating that the respective stage of the multi-stage invoice handling process has been completed (pages 1-22, specifically such as page 14, paragraph 96; page 19, paragraph 124; page 21, paragraphs 137 and 139; page 22, paragraph 143).

It would be obvious to one of ordinary skill in the art at the time of the invention to modify the authorization process for an online invoice as disclosed by Virgin to adapt the use of notifying a biller of invoice authorization progress as disclosed by Ludwig. The motivation would be to provide a means of tracking the progress of obtaining invoice approvals where the invoicer is not required to take the active step of reviewing the status (Virgin requires active viewing of approval/authorization steps whereas Ludwig provides automatic notification of each successive approval/authorization step).

### ***Response to Arguments***

Examiner acknowledges receipt of Affidavits filed with the amendment submitted on May 1, 2007 and January 17, 2008. While the examiner thanks the Applicant for the Affidavits as filed, Applicant is reminded of the requirements for swearing behind a reference used as prior art, the primary requirements set forth in sections 715 and 2138 of the MPEP. Section 715 provides the basic requirements for swearing behind a reference. Examiner specifically points to sections 2138.01 and 2138.06 as it relates to the deficiencies of the presently submitted Affidavits in establishing attorney and engineering due diligence from the time of the prior art reference date (April 3, 2001)

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and the filing of the present application (April 30, 2001), where applicant must account for the entire time period for which diligence is required, where the time period must be accounted for by affirmative acts or acceptable excuses (see below). For purposes of expeditiously pointing to the relevant portions of MPEP in addressing the deficiencies of the present Affidavits, the portions of MPEP below are provided.

### **2138.06 [R-1] "Reasonable Diligence"**

The diligence of 35 U.S.C. 102(g) relates to rea-sonable "attorney-diligence" and "engineering-diligence" (*Keizer v. Bradley*, 270 F.2d 396, 397, 123 USPQ 215, 216 (CCPA 1959)), which does not require that "an inventor or his attorney ... drop all other work and concentrate on the particular invention involved..." *Emery v. Ronden*, 188 USPQ 264, 268 (Bd. Pat. Inter. 1974).

### **CRITICAL PERIOD FOR ESTABLISHING DILIGENCE BETWEEN ONE WHO WAS FIRST TO CONCEIVE BUT LATER TO REDUCE TO PRACTICE THE INVENTION**

The critical period for diligence for a first conceiver but second reducer begins not at the time of conception of the first conceiver but just prior to the entry in the field of the party who was first to reduce to practice and continues until the first conceiver reduces to practice. *Hull v. Davenport*, 90 F.2d 103, 105, 33 USPQ 506, 508 (CCPA 1937) ("lack of diligence from the time of conception to the time immediately preceding the conception date of the second conceiver is not regarded as of importance except as it may have a bearing upon his subsequent acts"). What serves as the entry date into the field of a first reducer is dependent upon what is being relied on by the first reducer, e.g., conception plus reasonable diligence to reduction to practice (*Fritsch v. Lin*, 21 USPQ2d 1731, 1734 (Bd. Pat. App. & Inter. 1991), *Emery v. Ronden*, 188 USPQ 264, 268 (Bd. Pat. Inter. 1974)); an actual reduction to practice or a constructive reduction to practice by the filing of either a U.S. application (*Rebstock v. Flouret*, 191 USPQ 342, 345 (Bd. Pat. Inter. 1975)) or reliance upon priority under 35 U.S.C. 119 of a foreign application (*Justus v. Appenzeller*, 177 USPQ 332, 339 (Bd. Pat. Inter. 1971) (chain of priorities under 35 U.S.C. 119 and 120, priority under 35 U.S.C. 119 denied for failure to supply certified copy of the foreign application during pendency of the application filed within the twelfth month)).

**THE ENTIRE PERIOD DURING WHICH DILIGENCE IS REQUIRED  
MUST BE ACCOUNTED FOR BY EITHER AFFIRMATIVE ACTS OR  
ACCEPTABLE EXCUSES**

An applicant must account for the entire period during which diligence is required. *Gould v. Schawlow*, 363 F.2d 908, 919, 150 USPQ 634, 643 (CCPA 1966) (Merely stating that there were no weeks or months that the invention was not worked on is not enough); *In re Harry*, 333 F.2d 920, 923, 142 USPQ 164, 166 (CCPA 1964) (statement that the subject matter “was diligently reduced to practice” is not a showing but a mere pleading). A 2-day period lacking activity has been held to be fatal. *In re Mulder*, 716 F.2d 1542, 1545, 219 USPQ 189, 193 (Fed. Cir. 1983) (37 CFR 1.131 issue); *Fitzgerald v. Arbib*, 268 F.2d 763, 766, 122 USPQ 530, 532 (CCPA 1959) (Less than 1 month of inactivity during critical period. Efforts to exploit an invention commercially do not constitute diligence in reducing it to practice. An actual reduction to practice in the case of a design for a three-dimensional article requires that it should be embodied in some structure other than a mere drawing.); *Kendall v. Searles*, 173 F.2d 986, 993, 81 USPQ 363, 369 (CCPA 1949) (Diligence requires that applicants must be specific as to dates and facts.).

The period during which diligence is required must be accounted for by either affirmative acts or acceptable excuses. *Rebstock v. Flouret*, 191 USPQ 342, 345 (Bd. Pat. Inter. 1975); *Rieser v. Williams*, 225 F.2d 419, 423, 118 USPQ 96, 100 (CCPA 1958) (Being last to reduce to practice, party cannot prevail unless he has shown that he was first to conceive and that he exercised reasonable diligence during the critical period from just prior to opponent’s entry into the field); *Griffith v. Kanamaru*, 816 F.2d 624, 2 USPQ2d 1361 (Fed. Cir. 1987) (Court generally reviewed cases on excuses for inactivity including vacation extended by ill health and daily job demands, and held lack of university funding and personnel are not acceptable excuses.); *Litchfield v. Eigen*, 535 F.2d 72, 190 USPQ 113 (CCPA 1976) (budgetary limits and availability of animals for testing not sufficiently described); *Morway v. Bondi*, 203 F.2d 741, 749, 97 USPQ 318, 323 (CCPA 1953) (voluntarily laying aside inventive concept in pursuit of other projects is generally not an acceptable excuse although there may be circumstances creating exceptions); *Anderson v. Crowther*, 152 USPQ 504, 512 (Bd. Pat. Inter. 1965) (preparation of routine periodic reports covering all accomplishments of the

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laboratory insufficient to show diligence); *Wu v. Jucker*, 167 USPQ 467, 472-73 (Bd. Pat. Inter. 1968) (applicant improperly allowed test data sheets to accumulate to a sufficient amount to justify interfering with equipment then in use on another project); *Tucker v. Natta*, 171 USPQ 494,498 (Bd. Pat. Inter. 1971) (“[a]ctivity directed toward the reduction to practice of a genus does not establish, *prima facie*, diligence toward the reduction to practice of a species embraced by said genus”); *Justus v. Appenzeller*, 177 USPQ 332, 340-1 (Bd. Pat. Inter. 1971) (Although it is possible that patentee could have reduced the invention to practice in a shorter time by relying on stock items rather than by designing a particular piece of hardware, patentee exercised reasonable diligence to secure the required hardware to actually reduce the invention to practice. “[I]n deciding the question of diligence it is immaterial that the inventor may not have taken the expeditious course....”).

### **Conclusion**

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication should be directed to Jennifer Liversedge whose telephone number is 571-272-3167. The examiner can normally be reached on Monday - Friday, 8:30 AM - 5 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kambiz Abdi can be reached at 571-272-6702. The fax number for the organization where the application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Jennifer Liversedge

Examiner

Art Unit 3692

/Kambiz Abdi/  
Supervisory Patent Examiner, Art Unit 3692